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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/661,520	09/13/00	WILK	P W07-469

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EXAMINER	
NGUYEN, K	
ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/661,520	WILK, PETER J.	
	Examiner	Art Unit	
	Kien T. Nguyen	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh.

In re claims 1-5, Saitoh disclosed a novelty item comprising a housing (1) in the form of a bird, a sound reproduction system (43) mounted in the housing so as to remain hidden from casual visual inspection of the housing, a switch (44) mounted in the housing and operatively connected to the sound system (43) for activating same in response to a moving of the housing near a human body. The switch or sensor (44) may be pyroelectric sensor for detecting infrared rays radiated from a human body (see column 4, lines 17-20). The sound reproduction of Saitoh inherently includes a power source, a solid-state memory (46) that includes a conventional electroacoustic transducer (47). It is noted that Saitoh did not specifically teach the housing is in the form of a seashell, and other types of switches such as gravity or proximity sensors as set forth in these claims. However, the difference in the shape of the housing appears

Regarding the different types of switches, the specification of this application indicated that different types of switches are merely alternative forms of a sensor (see pages 6-8 of this application) and one sensor does not appear to have any significant advantage over the others. Therefore, it would have been obvious to one of ordinary skill in the art to modify the sensor (44) of Saitoh with any equivalent sensor that is commercially available.

Regarding claims 7-12, 14-16, it is noted that Saitoh teaches that the sensor (44) detects infrared rays emitted from a person causing the control circuit (45) to actuate the sound system (43) (see column 4, lines 31-39). It is noted that Saitoh does not specifically teach a step of after and only after a removal of the housing from a stationary position towards an ear of a user, a sound is reproduced. On page 7 of the present application, one of the alternative switches may be infrared sensor 32 (Fig. 5) for detecting the temperature of a body placed next to mouth opening 12. It is submitted that since the sensor (44) of Saitoh is virtually same as one of the alternative sensors as disclosed by the applicant, the infrared sensor of Saitoh is certainly more than capable of being programmed and/or adjust to detect the temperature of an ear of the user.

of the sound bits on successive activations of the sound reproduction system by the switch. However, Curran teaches an interactive talking toy having a sound reproduction system with a memory (36) storing a plurality of different sound bites (39, 41, 43) (see column 2, lines 53-60), and means (55) (see column 3, and Fig. 4) for accessing different ones of the sound bites on successive activations of the sound system. Therefore, it would have been obvious to one of ordinary skill in the art to modify the sound reproduction system (43) of Saitoh with the a memory (36) and means (55) as taught by Curran for the purpose of providing a wide variety of sound to the user.

Response to Arguments

In response to applicant's argument that Saitoh failed to teach a switch connected to a sound reproduction system in a housing for activating that system after and only after the housing is lifted to an ear of a user as set forth in claims 1, 7, 10, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As discussed above, since the sensor (44) of Saitoh is same as one of the alternative sensors as disclosed a[illegible] of th[illegible]

Applicant's arguments with respect to claims 13 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kien T. Nguyen whose telephone number is (703) 308-2493. The examiner can normally be reached on 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacob Ackun can be reached on (703) 308-3867. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Kien T. Nguyen
Primary Examiner